

Application No. 09/412,082
Amendment dated July 27, 2006
Reply to Office Action of June 12, 2006

REMARKS

Applicant amended claims 26 and 36 to further define Applicant's claimed invention.

Applicant respectfully notes that the listing of claims pending on the Form PTOL-326 is incorrect. Applicant submits that the listing of claims pending in the present application should read "18-38." Applicant respectfully submits that the next action cannot be made final because Applicant has not received an action on the merits for independent claim 38.

In the Office Action, the Examiner rejected claims 18-24 and 29-37 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,263,953 to Bagby ("Bagby"). Applicant respectfully traverses the Examiner's rejection. Independent claim 18 recites the step of forming a bore "having opposed arcuate portions in an angular relationship to one another along at least a portion of each of the adjacent vertebral bodies." Bagby teaches that "[t]he bony surfaces are next prepared for implantation by cutting cylindrical longitudinal beds into them." (Bagby, col. 6, lines 30-31 (emphasis added)). Bagby does not teach or suggest the step of forming a bore with opposed arcuate portions in an angular relationship to one another as recited in independent claim 18 of Applicant's claimed invention.

Moreover, Bagby does not teach or suggest the subject matter of many of Applicant's dependent claims. For example, dependent claim 22 recites where the inserting step "includes the sub-step of inserting said implant having at least one truncated side." Dependent claim 23 recites where the distracting step "includes the sub-step of inducing angulation to the adjacent vertebral bodies." Dependent claim 36, which is dependent from claim 25, recites the further step of "placing an inner sleeve within said sleeve prior to the step of forming the bore." Dependent claim 37, which is dependent from claim 36, recites the further step of "removing said inner sleeve prior to the step of inserting said implant." Bagby does not teach or suggest the subject matter of any one of dependent claims 22, 23, 36, and 37. Applicant submits that the rejection

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of claims 18-24 and 29-37 under 35 U.S.C. § 102(b) as being anticipated by Bagby has been overcome.

The Examiner rejected claims 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Bagby in view of U.S. Patent No. 4,878,915 to Brantigan ("Brantigan"). Applicant traverses the Examiner's rejection. Dependent claim 25 recites the further step of "positioning a sleeve over said spinal distractor and into contact with the adjacent vertebral bodies." The Examiner states that "Brantigan teaches in figure 4 a method of inserting a spinal implant comprising positioning a sleeve 33 over a spinal distractor (the drill)." (Office Action, paragraph bridging pages 2-3). The drill disclosed by Brantigan is not a distractor. A distractor is an instrument that urges apart adjacent vertebral bodies when inserted therebetween. The drill disclosed by Brantigan removes portions of the adjacent vertebral bodies and is not meant to distract the adjacent vertebral bodies apart. (See, e.g., Brantigan, Fig. 4). Neither Bagby nor Brantigan, whether alone or in proper combination, teach or suggest positioning a sleeve over a spinal distractor as recited in claim 25 of Applicant's claimed invention.

Dependent claim 26 recites the distracting step including the further step of "positioning a sleeve having an extension so that the extension is inserted into the disc space and bears against end plates of the adjacent vertebral bodies." Brantigan teaches positioning a drill guard 22 with "teeth or prongs 23 penetrating and anchored in the posterior side of both vertebrae." (Brantigan, col. 5, lines 43-45; Fig. 4). Neither Bagby nor Brantigan, whether alone or in proper combination, teach or suggest positioning a sleeve having extensions as recited in claim 26 of Applicant's claimed invention. Applicant submits that the Examiner's rejection of claims 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Bagby in view of Brantigan has been overcome.

The Examiner rejected claims 27 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Bagby and Brantigan, in further view of U.S. Patent No. 3,875,595 to Froning ("Froning"). Applicant respectfully traverses the Examiner's rejection. The Examiner states that "[i]t would have been obvious to one having ordinary skill in the art

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at the time that the invention was made that the implant disclosed by Bagby could be inserted through a sleeve as taught by Froning in order to prevent damaging the implant during the insertion step." (Office Action, page 3, paragraph 2). Applicant submits that the Examiner's motivation to support the combination of Froning with Bagby and Brantigan is insufficient. Bagby teaches that "coil 10 must also have sufficient compressive strength and elasticity to maintain separation between the bone surfaces of a prepared joint when implanted." (Bagby, col. 5, lines 2-4). Applicant submits that a person of ordinary skill in the art would not use a sleeve such as taught by Froning in order to protect a Bagby-type implant from any "damage" from the soft tissues outside of the disc space during the insertion step when the implant possesses strength sufficient to maintain separation between vertebral bodies. Accordingly, Applicant submits that the combination of Froning with Bagby and Brantigan cannot be maintained.

Moreover, dependent claim 28 recites where the positioning step includes the sub-step of "inducing angulation to the adjacent vertebral bodies." None of Bagby, Brantigan, and Froning, whether alone or in proper combination, teach or suggest inducing angulation to the adjacent vertebral bodies as recited in claim 28 of Applicant's claimed invention. Applicant submits that the Examiner's rejection of claims 27 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Bagby and Brantigan, in further view of Froning has been overcome.

Applicant submits that independent claims 18 and 38 are patentable and that dependent claims 19-37 dependent from independent claim 18, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

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To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

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Dated: July 27, 2006

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